

AMENDMENT UNDER 37 C.F.R. 1.116

EXPEDITED PROCEDURE

EXAMINING GROUP 2124

PATENT

Serial No. 09/697,419

Attorney Docket No. 1999P07938US01 (1009-045)

REMARKS

Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 4, 5, 7, 9, and 11 has been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification thereby not narrowing the scope of the claim, to detect infringement more easily, to enlarge the scope of infringement, to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.), to expedite the issuance of a claim of particular current licensing interest, to target the claim to a party currently interested in licensing certain embodiments, to enlarge the royalty base of the claim, to cover a particular product or person in the marketplace, and/or to target the claim to a particular industry.

Claims 4-11 are now pending in this application. Claims 4, 5, 7, 9, and 11 are the independent claims.

I. The Objection to Claims 4, 5, 7, 9, and 11

Claims 4, 5, 7, 9, and 11 were objected to for informalities. Claims 4, 5, 7, 9, and 11 have been amended to correct these informalities. Therefore, Applicants respectfully submit that any grounds for this objection, and respectfully request acknowledgment thereof.

II. The Objection to Claims 5, 7, 9, and 11

Claims 5, 7, 9, and 11 were objected to because there is an inconsistency between the limitations recited as “binary programmable logic controller program” and “binary programmable

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logic control program". Claims 5, 7, 9, and 11 have been amended to correct this inconsistency. Therefore, Applicants respectfully submit that any grounds for this objection, and respectfully request acknowledgment thereof.

III. The Indefiniteness Rejection

Claim 7 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite. This rejection is respectfully traversed.

Claim 7 has been amended to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, per the Examiner's suggestion. Thus, reconsideration and withdrawal of this rejection is respectfully requested.

IV. The Obviousness Rejection

Claims 4-9 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Agrawal (U.S. Patent No. 5,179,716) in view of Gates (U.S. Patent No. 4,969,083) and/or Kaiser (U.S. Patent No. 4,527,247). These rejections are respectfully traversed.

None of the cited references, either alone or in any combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

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expectation of success must both be found in the prior art, and not based on applicant's disclosure." See MPEP § 2143.

The Office Action recites "Agrawal does not explicitly disclose that implementing said PLC I/O functions is from a compilation comprising a support kernel. But in view of Agrawal's teachings as to be able to initialize the power settings or memory or power-up of the controller (e.g. col. 18, lines 32-45; Fig. 1), such kernel related support instructions is implicitly disclosed because of the must-have nature of kernel support in every system being programmed for actualizing its very functionality". The Office Action appears to infer that compiling a "user program and a system support kernel" is inherent in Agrawal. Inherency "requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002). No evidence has been presented that the admittedly "missing descriptive material is 'necessarily present'" in Agrawal.

Each of independent claims 4, 5, 7, 9, and 11 recite a "single chip program execution device" separable from a "communication/programming device" wherein the "communication/programming device" combines a **"user program and a system support kernel"** into a single executable "module". The "system support kernel" is "adapted to provide said programmable logic controller with operating system functions comprising sequencing the user program." Agrawal does not expressly or inherently teach or suggest a "single chip program execution device" separable from a "communication/programming device" wherein the "communication/programming device" combines a **"user program and a system support kernel"** into a single executable "module". Neither Gates nor Kaiser overcomes the deficiencies of Agrawal.

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Thus, even if there were motivation or suggestion to modify or combine the cited references (an assumption with which the applicant disagrees), and even if there were a reasonable expectation of success in combining or modify the cited references (another assumption with which the applicant disagrees), the cited references still do not expressly or inherently teach or suggest **every** limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted.

Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

V. Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter:

claims 4-11 recite a “single chip program execution device” separable from a “communication/programming device” wherein the “communication/programming device” combines a “**user program** and a **system support kernel**” into a single executable “module”, which none of the art of record teaches or suggests.

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CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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